



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,781	09/19/2005	Tai-Tung Yip	035394-0265	8494
22428	7590	10/31/2007		
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER ARCHIE, NINA	
			ART UNIT 1645	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/508,781	<b>Applicant(s)</b> YIP ET AL.	
	<b>Examiner</b> Nina A. Archie	<b>Art Unit</b> 1645	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

1. Group I: claims 1-7 drawn to a method for qualifying hepatocellular carcinoma status in a subject.
2. Group II: claims 8-10 drawn to a kit.
3. Group III: claims 11-14 drawn to software software for qualifying hepatocellular carcinoma status in a subject.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

4. The technical feature of Group I a method for qualifying hepatocellular carcinoma status in a subject. The technical feature of Group 1 is anticipated by Yang et al US Patent No. 5,702,907 Date Dec. 30, 1997. Yang et al teaches a method for qualifying hepatocellular carcinoma status in a subject comprised of analyzing a biological sample from said subject for a diagnostic level of a protein.
5. The technical feature of Group II is a kit.
6. The technical feature of Group III is software for qualifying hepatocellular carcinoma status in a subject.

### **Protein Election Requirement to Group I, Group II, or Group III**

In addition, Groups I, II, and III detailed above, read on patentably distinct sequences. Each protein is patentably distinct because they are structurally different and a further restriction is applied to each Group.

For Groups I, II, and III choose a single protein from the list of proteins below.

Art Unit: 1645

List of proteins;

I-M1, I-M2, I-M3, I-M4, I-M5, I-M6, I-M7, I-M8, I-M9, I-M10, I-M11 I-M12, I-M13, I-M14, I-M15, I-M16, I-M17, I-M18, I-M19, I-M20, I-M21 I-M22, I-M23, I-M24, I-M25, I-M26, I-M27, I-M28, I-M29, I-M30, I-M31 I-M32, I-M33, I-M34, I-M35, I-M36, I-M37, I-M38, I-M39, I-M40, I-M41, I-M42, I-M43, I-M44, I-M45, I-M46, I-M47, I-M48, I-M49, I-M50, I-M51, I-M52, I-M53, I-M54, I-M55, I-M56, I-M57, I-M58, I-M59, I-M60, I-M61, I-M62, I-M63, I-M64, I-M65, I-M66, I-M67, I-M68, I-M69, I-M70, I-M71, I-M72, I-M73, I-M74, I-M75, I-M76, I-M77, I-M79, I-M80, I-M81 I-M82, I-M83, I-M84, I-M85, I-M86, I-M87, I-M88, I-M89, I-M90, I-M91, I-M92, I-M93, I-M94, I-M95, I-M96, I-M97, I-M98, I-M99, I-M100, W-M1, W-M2, W-M3, W-M4, W-M5, W-M6, W-M7, W-M8, W-M9, W-M10, W-M11, W-M12, W-M13, W-M14, W-M15, W-M16, W-M17, W-M18, W-M19, W-M20, W-M21, W-M22, W-M23 W-M24, W-M25, W-M26, W-M27 W-M28, W-M29, W-M30, W-M31 W-M32, W-M33, W-M34, W-M35 W-M36, W-M37, W-M38, W-M39 W-M40, W-M41, W-M42, W-M43 W-M44, W-M45 W-M46, W-M47 W-M48, W-M49, W-M50, W-M51 W-M52, W-M53 W-M54, W-M55 W-M56 W-M57, W-M58, W-M59 W-M60, W-M61 W-M62, W-M63 W-M64, W-M65, W-M66 W-M67, W-M68 W-M69, W-M70, W-M71 W-M72, W-M73, W-M74 W-M75, W-M76 W-M77, W-M79, W-M80 W-M81, W-M82, W-M83 W-M84, W-M85 W-M86, W-M87, W-M88 W-M89, W-M90, W-M91 W-M92, W-M93 W-M94, W-M95, W-M96 W-M97, W-M98, W-M99 W-M100.

**Applicant is advised that examination will be restricted to only the elected protein should not be construed as a species election.**

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nina Archie whose telephone number is 571-272-9938. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1645

A handwritten signature in cursive script, appearing to read "Nina Archie".

Nina Archie  
Patent Examiner  
Art unit, 1645  
Remsen 3B31

A handwritten signature in cursive script, appearing to read "Mark Navarro".

MARK NAVARRO  
PRIMARY EXAMINER